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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,790	12/01/2000	Paul Pere	400-101	8499

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Elliott N Kramsky
5850 Canoga Avenue Suite 400
Woodland Hills, CA 91367

EXAMINER

ZAND, KAMBIZ

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/701,790

Applicant(s)

PERE, PAUL

Examiner

Kambiz Zand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/13/2005 & 06/27/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Kambiz Zand


Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/13/2005 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
3. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
4. New claims 25-36 have been added.
5. Claims 1-53 have been considered.

Response to Arguments

6. Applicant's arguments filed 05/13/2005 have been fully considered but they are not persuasive.
 - In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "wherein data is stored where it is generated (data access system) for

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sharing with other third party data access system upon approval by the patient-subscriber", page 10 and 11 of the Applicant's response), examiner refers applicant to the following remarks:

A recitation directed to the manner in which a claimed apparatus/methods is intended to be used does not distinguish the claimed apparatus/methods from the prior art if prior art has the capability to do so perform (See MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987)). The prior art is replete with references disclosing storing information (sensitive, encrypted or otherwise normal data, medical data, etc..). therefore the location where data is stored for access by any entity in a network environment is a design choice and not an inventive steps over the prior art.

- In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e, " storing the data only once", "not accessible to the owner of the rights", page 12-14 of the Applicant's response), examiner refers applicant to the following remarks:

A recitation directed to the manner in which a claimed apparatus/methods is intended to be used does not distinguish the claimed apparatus/methods from the prior art if prior art has the capability to do so perform (See MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987)). The prior art is replete with references disclosing storing information (sensitive, encrypted or otherwise normal data, medical data, etc..), therefore the number of times and where data is stored for access by any entity in a network environment is a design choice and not an inventive steps over the prior art. Further more the prior art disclose access by authorized entity (see page 3, line 20 Shultz), therefore giving access to an authorized entity or denying access to an entity (such as owner right) is a design choice and not an inventive steps over prior art. Also giving access by whom to who is well known in the prior art (As an example: such as administrator authority distributing access levels and authorities of the entities within a network systems in windows NT, Novell, Unix operating systems).

Claim Rejections - 35 USC § 103

7. **Claims 1-36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shultz et al (WO 98/15910) in view of Carter (5787175).

With respect to Claims 1 and 25, Shultz et al meets the limitation of the method for secured access to data in a network including an information center and a plurality of data area access systems in which permission to store said data and to define at the information center, access rights of third parties to said data is limited to the owner of rights to said data" on page 3, lines 1-9, 26-30; and in each case storing the data only once in one of said data area access systems not accessible to the owner of the rights" on page 2, lines 28-30, page 3, lines 1, 12-14; and registering the presence of data of a certain type in each data area access system at said information center, followed by the owner of the rights to the stored data should he wish, defining access rights of third parties to said data at said information center" is met on page 2, lines 28-30 and page 3, lines 26-28,. and (transmitting a list of the data present of a certain type, specifying the data area access system storing said data, and said information center to a requesting data area access system" is met inherently by page 5, lines 3-5., and on page 4, lines 18-25,. and "directly transmitting said data of said certain type by said data area access system storing said data to said requesting data area access system subject to said data area access system storing said data having received a confirmation from said

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information center" on page 3, lines 20-23 and 26-30 and on page 4, lines 1-4. The password and WWW address verification inherently discloses a confirmation signal being sent from the information center. This is because the information center verifies the password and address and must send a signal to communicate a successful verification to the data access system. Schultz however does not meet the limitation disclosed below.

The limitation of the access rights of said requesting data area access system correspond to the access rights defined at said information center for said data" is met by Carter on column 3, lines 31-42.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Carter within the system of Schultz because an access list that is modifiable by the user can help the user prevent someone who already had previous access from gaining future access to his medical record. This hence gives the user more control over who he/she wants to view his/her medical records.

With respect to Claim 2, the limitation of "wherein an authorization of the storage of data and of the definition of the access rights of third parties to the data takes place by means of an identity check of the owner of the rights to the data" is met by Shultz et al on page 44, lines 19-30 and page 45, lines 1-7. The password authentication is the identity check for the user.

With respect to Claim 3, the limitation of "wherein data to be stored are stored in said data area access system with an electronic form which contains the type of the data" is met by Shultz et al on page 44, lines 15-19.

With respect to Claims 4, the limitation of "wherein a data area access system storing data responds to a request for certain data of a certain type by a requesting data area access system by verifying the access rights through an inquiry to the information center as to whether the requesting data area access system has access rights to the certain data of a certain type" is met by Shultz et al on page 4, lines 28-30 and on page 5, line 1. The technician's password verifies his unique access rights to the information center.

With respect to Claim 5, the limitation of "wherein a data area access system receiving certain data of a certain type allows access to the received data only directly after a respective reception of said data" is met by Shultz et al on page 3, lines 29-30 and on Fig. 4. Access is allowed to the user as her/his password and a distinctive address are verified.

With respect to Claim 6, the limitation of "wherein a data area access system storing certain data of a certain type grants access to the certain data of a certain type only if a positive verification has taken place through an inquiry to the information center as to whether said data area access system storing said certain

data of a certain type can show access rights for said certain data of a certain type" is met by Shultz et al on page 4, lines 28-30. The password and address form the certain data that show access rights for the data to be accessed. The technician has a different password from the physicians and hence a different access right applies to him than for any other worker.

With respect to Claim 7, the limitation of "wherein the information center is notified by a data area access system having new data about the presence of new data of a certain type, whereupon said information center sends a notifying confirmation to the data area access system" is met by Shultz et al on page 4, lines 18-25. The subscriber or physician can update the patient's records.

With respect to Claim 8, the limitation of "wherein said data are identified on the basis of an identification which is allocated as a unique identification by said information center and is transmitted by said information center after a registration of new data to the data area access system storing said data, in order for said system to append the respective identification to the respective data" is met by Shultz et al on Fig. 3B. The network address is the identification sent to the user registers.

With respect to Claim 9, the limitation of "wherein an inquiry for data of a certain type by a data area access system, said information center prepares a list of all the data present of this certain type before it verifies the access rights to the data of the

certain type, in order to transmit the list of data present of this certain type, specifying the data area access system respectively storing these data, to the requesting data area access system for which the requesting data area access system can show said access rights" is met by Shultz et al on page 42, lines 12-25, and page 44, lines 1-4.

With respect to Claim 10, the limitation of "wherein when data access is desired by a data area access system to data of a certain type, firstly a request for such data of the certain type is sent to the information center" is met by Shultz et al on page 42, lines 12-15.

With respect to Claim 11, the limitation of "wherein when data transmission is desired from a data area access system storing data to a requesting data area access system, firstly a request for certain data of a certain type is sent by the latter system to the data area access system storing these pertain data of a certain type" is met by Shultz et al on page 42, lines 12-15.

With respect to Claim 12, the limitation of "wherein the data in a data area access system are stored in a secure data memory no direct access being possible to the data stored therein" is met by Shultz et al on page 11, lines 8-23.

With respect to Claim 13, the limitation of "wherein the type of the data is determined by their content and/or the owner of the rights to the data" is met by Shultz et al on page 3, lines 26-30.

With respect to Claim 14, all the limitation is met by Shultz et al except the limitation disclosed below.

The limitation of "wherein the access rights to stored data can be defined by the owner of the rights to the data at any point in time after their registration at the information center and, after that, can be changed again as desired by a re-definition by the owner of the rights to the data" is met by Carter on column 3, lines 31-42.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Carter within the system of Schultz because this allows the user more control over who can view his information. He can use this control to prevent a physician who already had access in the past from having access in the future due to personal reasons.

With respect to Claim 15, the limitation of "wherein the access rights to stored data can be granted by the owner of the rights to the data when they are stored in a data area access system" is met by Shultz on page 4, lines 14-17. The user sharing his password with any medical establishment of his choice achieves this.

With respect to Claim 16, the limitation of "wherein communication between a data area access system and the information center or another data area access system takes place in encrypted form" is obvious because encryption is a well known method of making data undecipherable to a common eye. The examiner takes official notice on the encryption of a patient's medical records because by law, a user's medical records cannot be sent out in clear, because this is confidential/secret information. Hence this will necessitate encryption, by law.

With respect to Claim 21, the limitation of "wherein a participant accessing the network must authorize himself and his identity is verified by the information center" is met by Shultz on page 44, lines 19-30 and on page 45, lines 1-7. The password and authentication reveals this.

With respect to Claim 23, the limitation of "wherein the permission for storing the data is given by the owner of the rights to the data at the latest when the data are registered at the information center, said information center not allowing any subsequent data access to these data without correct authorization" is met by Shultz on page 44, line's 19-30 and on page 45, lines 1-7 and on Fig. 3A and 4.

As per claims 26-36, the limitations are similar to the claims 3-14 and rejected as above claims.

8. **Claims 17-20 and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz et al (WO 98/15910) in view of Carter (5787175) in further view of Chen et al (5694471).

With respect to Claim 17, all the limitation is met by the combination of Schultz et al and Carter except for the limitation disclosed below.

The limitation of "wherein the sender provides the information sent by him with a digital signature by means of a secret signature code, whereby the recipient can verify the sent information by means of an associated public signature code" is met by Chen on column 2, lines 9-39.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen within the combination of Shultz et al and Carter because a digital signature is a commonly used, well-known method for authenticating the sender of an information, and hence validate the sender's integrity to the receiver.

With respect to Claim 18, all the limitation is met by the combination of Schultz et al and Carter except for the limitation disclosed below.

The limitation of "wherein the sender encodes all transmitted data by means of a public encryption code issued by the recipient, whereby only the recipient can decode the transmitted data by means of a secret encryption code" is met Chen on column 1, lines 40-51.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen within the combination of Schultz et al and Carter because public key encryption is a well-known means for encrypting data, whereby either side has a different encryption key. Public key encryption is utilized by RSA, a well-known encryption scheme.

With respect to Claim 19, all the limitation is met by the combination of Schultz et al and Carter except for the limitation disclosed below.

Chen meets the limitation of "wherein not only each data area access system and the information center but also each participant has a secret signature code and a secret encryption code and a public signature code and a public encryption code" on column 1 lines 40-51 and on column 1, lines 6-22. The public signature code is obvious from the private signature code because it will be needed to decrypt the encrypted signature.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen within combination of Shultz et al and Carter because of the reasons stated above for Claims 17 and 18.

With respect to Claim 20, all the limitation is met by the combination of Schultz et al and Carter except for the limitation disclosed below.

The limitation of "wherein the secret signature codes and encryption codes and/or public signature codes and encryption codes of a participant are stored on a data carrier, such as a smart card" is met by Chen on column 3, lines 52-62.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen within the combination of Shultz et al and Carter because of the reasons stated above for Claims 17 and 18.

With respect to Claim 22, all the limitation is met by the combination of Schultz et al and Carter except for the limitation disclosed below.

The limitation of "wherein the identity of a participant is stored on a data carrier such as a smart card" is met by Chen on column 2, lines 9-15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen within the combination of Schultz et al and Carter because this would lead to a quicker user authentication since the information center need not be contacted to authenticate the user, but simply by authenticating the user by insertion of a smart card to a reader/terminal.

9. **Claim 24** is rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz et al (WO98/15910) in view of Carter (5787 175) in further view of Auerbach et al (5673316).

With respect to Claim 24, all the limitation is met by the combination of Schultz et al and Carter except the limitation of an electronic watermark used for authentication.

This is met by Auerbach et al on column 4, lines 40-42.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Auerbach et al within the combination of Schultz et al and Carter because watermarking is a well-known method of copy protection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally be reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Kambiz Zand', with a stylized, cursive script.

Kambiz Zand

08/03/2005

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